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EXAMINER

PARK, ILWOO

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,144	WOOD, ROBERT BARRY	
	Examiner	Art Unit	
	Ilwoo Park	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6, 16, and 18 are amended and claims 24-28 are added in response to the last office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 contains the trademark/trade name Linux. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an operating system and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 18, 19, 22, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefanksy [US 6,226,143 B1].

As for claim 1, Stefanksy teaches a device [disk drive] comprising:

a data disc [rotating disk 44 in fig. 2] rotatably mounted on a baseplate [base 20 in fig. 1];

a printed circuit board (PCB) [PCB 36 in fig. 1] fastened to the baseplate having a servo controller; and

a central processing unit (CPU) [microcontroller 224 in fig. 14] mounted to the PCB running [col. 8, lines 25-40] an operating system.

As for claim 18, Stefanksy teaches an intelligent storage element [disk drive] comprising:

a case forming a substantially sealed environment [col. 5, lines 48-60];

a data disc [rotating disk 44 in fig. 2] mounted within the case [fig. 1];

a central processing unit (CPU) [microcontroller 224 in fig. 14] mounted within the case; and

a memory mounted within the case, wherein the memory stores [col. 8, lines 25-40] an operating system, and the central processing unit runs the operating system.

As for claim 19, Stefanksy teaches the data disc is a magnetic data storage media [col. 4, lines 60-64].

As for claim 22, Stefanksy teaches the case comprising a base and a top cover [base 20 and cover 24 in fig. 1].

As for claim 25, Stefanksy teaches a head [head 220 in fig. 14] that reads data from the data disc to produce a signal; and a channel [R/W CTL 236 in fig. 14] mounted to the PCB, wherein the channel receives the signal from the head.

As for claim 26, Stefanksy teaches the CPU generates control signals to the servo controller [e.g., col. 9, lines 19-28].

5. Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue [US 6,647,320 B1].

As for claim 16, Inoue teaches a device comprising: a printed circuit board (PCB) [motherboard 16 in fig. 2]; a central processing unit (CPU) [CPU 17 in fig. 2] mounted to the PCB running [col. 4, lines 8-15] an operating system; and a memory mounted on the PCB storing [col. 4, lines 43-46] an application program, wherein the application program is run by the operating system running in the CPU.

As for claim 17, Inoue teaches the memory stores both the operating system and the application program, wherein the application program for use by the CPU [col. 4, lines 43-46].

6. Claims 18, 20, 23, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Durrett [US 5,964,830].

As for claim 18, Durrett teaches an intelligent storage element [user portal device 10 in fig. 1] comprising:

- a case forming a substantially sealed environment [fig. 1];

- a data disc [col. 1, lines 62-65] mounted within the case;

a central processing unit (CPU) [e.g., CPU 20 in fig. 2] mounted within the case;
and

a memory mounted within the case, wherein the memory stores [col. 7, lines 29-31] an operating system, and the central processing unit runs the operating system [col. 2, lines 24-32].

As for claim 20, Durrett teaches a network interface module allowing the intelligent storage element to communicate across a network [col. 5, lines 23-30].

As for claim 23, Durrett teaches the operating system runs application software stored on the data disc [col. 1, lines 62-65; col. 6, lines 4-12].

As for claim 24, Durrett teaches the memory is random access memory [col. 7, lines 29-31].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanksy [US 6,226,143 B1] in view of Glover [US 6,282,045 B1].

As for claims 2 and 20, though Stefanksy teaches the device [disk drive] having an input/output module [interface control circuit 228 in fig. 14] is connected to a communications line [col. 8, lines 41-55], Stefanksy does not expressly disclose the communications line includes a communications network. Glover teaches a device [disk

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drive] has a central processing unit (CPU) [DSP 26 in fig. 1] running [col. 6, lines 26-43] an operating system and an input/output module [disk control circuitry 24 in fig. 1] directly connected [col. 3, lines 46-52; col. 3, lines 16-18] to a communications network for communicating to a node connected to the network. At the time of the invention, one of ordinary skill in the art would have been obvious to modify to include a device directly connecting to a communications network and communicating with a node connected to the network in order to increase flexibility rather than the device communicating with a network node through a personal computer or a server as taught by Glover [col. 3, lines 10-15; col. 4, lines 31-41].

As for claim 21, Glover teaches the network is a local area network [col. 3, lines 16-18].

9. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanksy [US 6,226,143 B1] in view of Glover [US 6,282,045 B1] as applied to claim 2 above, and further in view of Durrett [US 5,964,830].

As for claim 3, Glover teaches the input/output module includes a network interface module operable to communicate to a node on the network [col. 4, lines 31-41]. However, Glover does not explicitly disclose a hypertext transport protocol is used for the network communication. Durrett teaches a device [user portal device 10 in fig. 1] having an input/output module [e.g., col. 5, lines 23-30] capable of directly communicating with a node connected to a communications network using a hypertext transport protocol. At the time of the invention, one of ordinary skill in the art would have

been obvious to use a hypertext transport protocol as a network communication protocol in order to adapt the prevalent network protocol

As for claim 4, Durrett teaches the input/output module further including a video interface module to drive a video monitor via the communications network [e.g., internal VGA 53A, external VGA and NTSC 44 in fig. 5A].

As for claim 5, Stefanksy teaches the device is a three and one half inch form factor assembly [col. 5, lines 12-18].

As for claim 6, Glover teaches a file system managing file data stored on the data disc, wherein the file system is in direct communication with the servo controller [col. 6, lines 13-25; fig. 1].

10. Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefanksy [US 6,226,143 B1] in view of Durrett [US 5,964,830].

As for claim 27, Stefanksy does not disclose the data disc stores an application software run by the operating system. Durrett teaches a data disc stores an application software run by the operating system [col. 1, lines 62-65; col. 6, lines 4-12]. an intelligent storage element [user portal device 10 in fig. 1]. At the time of the invention, one of ordinary skill in the art would have been obvious to modify to combine the cited references in order to provide stand-alone capability as taught by Durrett [abstract].

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue [US 6,647,320 B1].

As for claim 28, Inoue the CPU runs the operating system. However, Inoue does not disclose the operating system is Linux operating system. The Linux operating

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system is well known in the art. At the time of the invention, one of ordinary skill in the art would have been obvious to modify to include the royalty free Linux operating system in order to reduce a product cost.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ilwoo Park whose telephone number is (571) 272-4155. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILWOO PARK
PRIMARY EXAMINER


Ilwoo Park

September 7, 2006